

RESPONSE TO ANTICIPATION REJECTION

Claims 1, 8, and 9 were rejected on grounds of anticipation, based on Griffith. Claim 1 recites:

1. A kit, comprising:
 - a) a number of tags, each attachable to an item;
 - b) a controller which has a scanning range and, when activated,
 - i) periodically inquires whether all tags are present within the scanning range and, if not,
 - ii) issues a warning.

Point 1

Applicant points out that claim 1 recites "a scanning range," which is singular in number. Griffith shows more than one scanning range. For example, his Figure 1 shows two INTERROGATOR UNITS 14. If a "scanning range" is present, then two such ranges would be present in his Figure 1.

Further, even if **one** of Griffith's ranges is selected, in an attempt to read claim 1 onto it, Griffiths still does not show the claim. Claim 1(b)(i) recites inquiring

. . . whether **all tags** are present within **THE** scanning range . . .

Griffith does not do that. For example, in his Figure 1, the

lowermost INTERROGATOR UNIT 14 does not interrogate the uppermost rows of TRANSPONDER UNITS 16. (See column 5, lines 45 - 52.)

Stated another way, in Griffith's Figure 1,

-- some TRANSPONDER UNITS 16 may be out-of-range of the lowermost INTERROGATOR UNIT 14, but the other INTERROGATOR UNIT handles those TRANSPONDER UNITS 16; and

-- conversely, some TRANSPONDER UNITS 16 may be out-of-range of the uppermost INTERROGATOR UNIT 14, but the other INTERROGATOR UNIT handles those TRANSPONDER UNITS 16.

Therefore, in Griffith,

-- there is no single "scanning range,"
-- nor is there a determination of whether "all tags" are present within that (single) "scanning range."

Point 2

Claim 1 recites a "kit." One definition of "kit" is "a set of parts to be assembled."

Griffith shows a system, which is already assembled. That is not a "kit." By analogy, everybody recognizes a model airplane "kit." It's a collection of parts, probably in a box, which can be glued together to form a toy airplane.

But the toy airplane, after assembly, is not called a "kit."
Griffith does not show a "kit."

Point 3

In brief: the warning signal in Griffiths does not correspond to the claimed warning.

Claim 1 states that the controller:

- i) periodically inquires whether all tags are present within the scanning range and, if not,
- ii) issues a warning.

Griffiths states, column 13, lines 8 - 10, that if a transponder fails to respond, the interrogator 14 issues a "warning of a missing transponder to the system controller 12." But Griffiths does not appear to state what the system controller 12 does in response.

The term "warning" must be given an interpretation consistent with Applicant's Specification. That is, the name which Griffiths gives to his signal is not relevant. Griffith's supposed "warning" is actually a collection of electronic bits, which he sends to the system controller 12. Those bits are not detectable by a human.

Applicant's Specification refers to a "warning, such as a beeping sound." (Summary of Invention, end of second paragraph.)

MPEP § 2106(II)(C) states:

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Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

MPEP § 2111 states:

PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, **taking into account whatever enlightenment by way of definitions OR OTHERWISE that may be afforded by the written description contained in applicant's specification.**

Applicant has given one definition of a warning, namely, a beeping sound. Under this MPEP section, that definition "will control."

And the claimed warning **does not** cover signals which are not detectable by humans, as in Griffiths.

MPEP § 2173.05(a) states:

During patent examination, the pending claims must be given the broadest reasonable interpretation **consistent with the specification.**

Applicant's Specification indicates that the "warning" is detectable by a human. The supposed warning in Griffiths is not.

MPEP § 2164.04 states:

For terms that . . . could have more than one meaning, it is necessary that the examiner

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select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action.

No definition has been selected by the Examiner.

Further, Applicant submits that the PTO is maintaining inconsistent positions. MPEP § 2173.05(n) states:

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms may be ascertained by reference to the description.

There is no support in the Specification for the notion that the claimed warning covers a signal which is not detectable by humans.

Further, it is axiomatic that, for a reference to **anticipate** a claim, the reference must **infringe** the claim. But there is no enablement in Applicant's Specification for the electronic signal which Griffiths calls a "warning." A patent cannot cover subject matter for which it is non-enabling.

Point 4

Claim 1 recites:

. . . a number of tags, each attachable to an item.

Griffith shows transponders **already attached** to items. Thus, they are not "attachable."

From another perspective, Griffith's transponders must be **removed** from items, in order to be "attachable." But if that is done, then Griffiths' system becomes inoperative.

A reference cannot be interpreted in a manner which renders it inoperative.

Or, if Griffiths is interpreted as having tags which are attachable to items, then Griffiths is being rendered inoperative. An inoperative reference cannot anticipate a claim.

Point 5

In brief: Griffith's system requires programming by a human, in order to operate. Thus,

-- **prior to programming**, Griffiths' system lacks the properties recited in claim 1 (no "warning" can be issued: the system is inoperative);

-- **at the time of programming**, Griffiths' system still lacks the properties recited in claim 1 (no determination is made of whether **all** tags lie in a **single** scanning range, and the tags are not "attachable" but already attached).

Prior to the time Griffith's system becomes operational, no "kit" as in claim 1 exists. That is, Griffith, column 4, line 43 et seq., indicates that his "controller 12" (a Personal Computer) receives input from a user which does things like establish the ID numbers for the transponders. (See column 5, line 15.)

Griffith specifically states:

In the general operation of the system . . .
first, an operator enters the operating
parameters 121 . . .

The system controller 12 then outputs system
commands to the interrogator(s) 14.

(Column 5, lines 24 - 31.)

Therefore, until Griffith's human operator sets up the "operating parameters," Griffith's system does nothing. For example, the "operating parameters" includes the ID numbers of the transponders. Until those are established, no transponders are interrogated.

Without interrogation, the transponders do not respond, and Griffith cannot tell if a transponder is out-of-range, inactive, etc.

Consequently, **prior to this programming**, Griffith's transponders do nothing relevant to claim 1. The elements of claim 1 are not present at this time.

And when the programming occurs, no "kit" is present, and no transponders "attachable to items" are present. Griffiths' system

has already been set up.

The preceding applies to claims 8 and 9.

Claim 9

Claim 9 recites a testing function, which is in addition to the periodic inquiry function of claim 1. The Specification, page 7, paragraph beginning with, "In one form of the invention, a testing routine is run," provides an explanation of the usefulness of such a function. For example, a user may believe that a tagged item was dropped. The user may not wish to wait until the next interrogation cycle, and may wish to learn right away whether the item was, in fact, lost. The testing function allows this.

The dual functions (testing and periodic inquiry) have not been shown in Griffiths. MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Added claim 19 is justified by the preceding discussion.

RESPONSE TO OBVIOUSNESS REJECTIONS

Claims 2 - 7 and 10 were rejected on grounds of obviousness, based on Griffith and Rich.

Claim 6 recites:

6. A method, comprising:

a) maintaining N remotely addressable tags in a purse, wherein each tag responds to an interrogation signal by returning an ID code, and

i) tag 1 returns ID code 1 after a time delay D1 following the interrogation signal;

ii) tag 2 returns ID code 2 after a time delay D2 following the interrogation signal;

iii) tag 3 returns ID code 3 after a time delay D3 following the interrogation signal, and so on, through

iv) tag N, which returns ID code N after a time delay DN following the interrogation signal.

Point 1

Sub-Point 1A

Appellant points out that, even if the references are combined, claim 6 is not attained. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Claim 6 states "maintaining N remotely addressable tags in a purse." "Tags" is plural in number. "Purse" is singular." Further, subsequent phrases in claim 6 refer to "tags" 1, 2, and 3. (Of course, more than three tags are possible.)

Thus, according to the claim, **multiple** "tags" are contained

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in a **single** "purse."

The Rich reference shows a **single** RFID device attached to a person (or in a wallet), which stores medical information.

Claim 6 does not read on that. Rich does not show the claimed **multiple** tags.

And why would Rich show multiple tags ? His tag stores medical information, and there is no need for multiple tags.

Sub-Point 1B

Again, even if the references are combined, the claim is not attained.

-- Griffiths shows **multiple** containers, each having an attached transducer.

-- Rich shows a **single** RFID card, within a wallet.

But neither reference shows **multiple** tags within a **single** purse. Nor does either reference discuss a need, or a function, for multiple tags within a single purse.

Even if the references are combined, there is no showing of **multiple** tags within a **single** purse.

Point 2

The combination does not follow the rules of obviousness.

Griffith is cited for the proposition of attaching the

transponders to multiple containers. The transducers indicate whether the multiple containers are present, and also indicate the contents of the containers, and the environment of the containers. (Column 2, lines 37 - 41; column 3, lines 1 - 3.)

Rich is cited for the proposition that one of the containers can be a wallet.

However, Rich explicitly states that his RFID card (containing medical information) can be kept in a wallet or purse. (Abstract, line 5.) Rich does not state that his wallet/purse is a generic container of the type shown in Griffiths. Thus, there is no reason to believe that Rich is suggesting that a wallet can replace a container of Griffiths.

Point 3

Applicant respectfully submits that the PTO's suggestion is contrary to common sense. Griffiths is discussing containers in a warehouse. If Griffiths were considering wallets, he would be considering a pallet full of wallets, not a single wallet.

Restated, individual wallets are not handled in Griffiths' environment.

It could be argued that Griffiths applies to material-handling generally, and that Griffiths would be applicable to a post office, which does handle individual packages, some of which contain single wallets. That may be so, but such an interpretation

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of the references has not been justified. No teaching for packaging the wallet of Rich into a post-office package has been made.

Point 4

The PTO's interpretation of Rich is contrary to Griffiths.

Griffiths states that the transponders are "attached to the containers." Column 2, line 20. (This makes sense. Many shipping containers are steel, which blocks rf transmissions. Thus, if the transponders were inside such containers, the rf communication would be blocked.)

Rich states that his RFID card can be carried **inside** a wallet. The references are contrary.

Point 5

The Office Action has not shown why Rich would need multiple containers. Thus, the teaching attributed to Rich is incomplete. The supposed teaching does not lead to a combination of references.

Point 6

No teaching has been given for combining the references.

One rationale given is this:

[It is obvious to combine the references] to be able to store and transport the tags within luggage because it is convenient to be able to

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have a container to keep valuable objects safe
and to track them with transponders.

(Office Action, page 5, first full paragraph.)

However, several problems exist in this rationale.

Problem 1

The rationale, in essence, states that, since Griffiths uses tags to track containers, those tags should be used within luggage. However, Griffiths does not "track" containers. That is, he does not follow containers from their origin to their destination. Thus, the rationale is based on a faulty premise.

Problem 2

As explained above, Griffiths attaches the tags **outside** the containers. That is contrary to the PTO's rationale, which is to place tags "within" luggage.

Problem 3

The rationale combines apples with oranges.

Griffiths uses tags for purposes such as (1) monitoring environment of containers and (2) ascertaining the contents of the containers. Griffiths states that his tags provide an inventory control system. "Inventory" is in his title.

Those functions have no relevance to luggage. Why would

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anyone want a system to ascertain the contents of their luggage ?
Who would pay for that ?

Problem 4

The rationale makes a leap from Griffiths' system, to placing tags into luggage. But there is no logical connection between Griffiths and luggage. And none has been shown.

-- What elements of Griffiths' system are used in luggage ?

-- Why would Griffiths' system be used in luggage ? When you travel, you have your luggage in your hand. And when you check your luggage at the airport, Griffiths' system is inapplicable.

Problem 5

No expectation of success has been shown in the combination of references. That is, MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . . .

Second, there must be a reasonable expectation of success.

. . . .
The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The rationale states that the goal is to "track" the moving transponders, now present in the luggage. But Griffith's interrogation system is **stationary**. No teaching has been given for making Griffith's interrogation system mobile.

Further, the rationale has not shown a tracking system in the prior art. Nor has the rationale explained how the elements of the two references would perform "tracking."

No expectation of success has been shown.

Problem 6

The rationale does not follow the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembiczak states that

- **objective evidence** of a teaching for combining references must be provided;
- the Examiner's speculation does not qualify as objective evidence;
- numerous sources can provide a teaching to combine references;
- knowledge of one skilled in the art can

act as a source;

-- however, THE RANGE OF SOURCES AVAILABLE
DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL
EVIDENCE;

-- broad conclusory statements by the
Examiner do not qualify as evidence; and

-- "particular factual findings" as to the
teaching are required, and gives reasons why
facts are necessary.

In this case, no findings of fact have been given, and it
appears that the rationale is a broad conclusory statement of the
Examiner.

The preceding discussion applies to claims 2 and 6. The
dependent claims are considered patentable, based on their parents.

Claim 10

Claim 10 recites:

g) if all tags are present, issuing
an all-present signal.

Applicant cannot locate the all-present signal in the references,
and requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132,
that the PTO specifically identify this signal.

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Added Claims

Support for the added claims can be found in the Specification at the following locations and others.

<u>Claim</u>	<u>Location of Support</u>
11	Figure 2, compared with Fig. 1
12	Figure 2: entire Figure is within field-of-view of reader
13	Figure 1, showing all elements of kit within purse, and Specification, [age 2, first paragraph of 'Detailed Description . . .', which states that purse of Figure 1 can represent brief case.
14, 15, 17	Abstract
16	Figure 1, "Detailed Description . . .", second paragraph, page 2.
18	Page 7, paragraph beginning "In one form of the invention . . ."

Claim 11

Claim 11 states that, in kit form, the tags are not attached to items. That is contrary to Griffiths.

Claim 12

Claim 12 states that the items in the kit are within the field-of-view of a person. Note that claim 12 does not state that

the person necessarily sees the items, but that "field-of-view" defines a region of space. That is contrary to Griffiths, which clearly indicates that his containers are distributed over a wide area.

Claim 13

Claim 13 states that the kit, in kit form, will fit into a brief case. The size of a brief case is well known: it holds legal briefs, which are written documents, generally around 50 - 100 pages, and on either 8-1/2 x 11 or 8-1/2 x 14 paper.

Griffiths is contrary to this: the tags of Griffiths are distributed throughout a giant warehouse.

Claims 14, 15, and 17

As explained herein, Griffiths does not issue an audible sound when a tag does not respond.

Claim 16

In Griffiths, the tags are already attached to things. Removing them would render Griffiths inoperative.

Claim 18

Claim 18 states that the ordinary inquiry of whether all tags are present proceeds, but, at the same time, a test can be run to

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see whether all tags are present. That is not shown in Griffiths.

Claim 19

Claim 19 states that all items are present in a single, portable package. Figure 1 literally shows this, although, in practice, a customer will probably not purchase the purse 3.

Figure 2, and the Specification, clearly indicate that the kit is purchased by a customer, and is therefore portable.

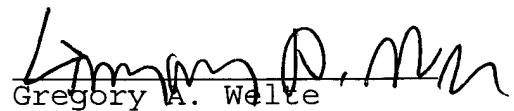
In Griffiths, the supposed kit is not portable, and not in a package.

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


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